

1617 #8
PATENT

Customer Number 22,852

Attorney Docket No.: 05725.0922-00

3-503

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

Isabelle ROLLAT et al.)

Application No.: 10/023,330)

Filed: December 20, 2001)

For: RESHAPABLE HAIR STYLING)
RINSE COMPOSITION COMPRISING)
(METH)ACRYLIC COPOLYMERS)

Group Art Unit: 161

Examiner: Lauren Q. ell

TECH CENTER: 600/2900

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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

In a restriction requirement dated January 29, 2003, the Examiner required
restriction under 35 U.S.C. § 121 between:

Group I: Claims 1-23, 28-55, 60-79, 84-108, 120-145, and 159-184, drawn
to a reshapable hair styling composition;

Group II: Claims 24, 56, 80, 110, and 146, drawn to an aerosol device;

Group III: Claims 25, 26, 57, 58, 81, 82, 111-116, and 147-154, drawn to a
method of using a composition; and

Group IV: Claims 27, 59, 83, 117-119, and 155-158, drawn to a method of
making a composition.

The restriction requirement is respectfully traversed. However, to be fully responsive
to the restriction requirement, Applicants elect, with traverse, to prosecute Group I,
claims 1-23, 28-55, 60-79, 84-108, 120-145, and 159-184.

Applicants traverse the restriction requirement on the grounds that the
Examiner has not met her burden to justify a restriction requirement. Specifically,

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while the Examiner has argued the four inventions to be distinct, nowhere has she addressed that there is a serious burden in examining all of the claims at once.

Applied Materials Inc. v. Advanced Semiconductor Materials, 40 U.S.P.Q.2d 1481, 1492 (Fed. Cir. 1996). In fact, "[i]f the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 (emphasis added).

Applicants submit that there is no serious burden upon the Examiner to examine Groups I, II, III, and IV together. The Examiner's burden is minimized by the fact that:

(1) the aerosol device claims of Group II comprise the reshapable hair styling compositions recited in various claims set forth in Group I -- the Examiner misconstrues the scope of the claims, when she asserts that the devices may be used as spray paint container. (Restriction at page 2). The claims of Group II are directed to those devices that comprise "an aerosol composition, which provides a reshapable effect and comprises a liquid phase comprising at least one composition comprising at least one (meth)acrylic copolymer," as defined various claims set forth in Group I;

(2) the methods of use claims of Group III utilize the reshapable hair styling compositions recited in various claims set forth in Group I -- the Examiner misconstrues the scope of the claims, when she asserts that the method of use may be practiced with a shampoo, condition, or any other hair care product. (Restriction

at page 3). The claims of Group III are directed to those methods of use "applying to the hair before shaping of a hairstyle of said hair a [reshapable hair styling] composition comprising at least one (meth)acrylic copolymer," as defined by various claims set forth in Group I; and

(3) the methods of manufacture claims of Group IV are directed to the reshapable hair styling compositions recited in various claims set forth in Group I -- the Examiner misconstrues the scope of the claims, when she asserts that the process may be used to make another product, such as a fixative gel to temporarily hold an object in place. (Restriction at page 3). The claims of Group IV are directed to those processes for manufacturing a "reshapable hair styling composition comprising including in a hair styling composition at least one (meth)acrylic copolymer," as defined by various claims set forth in Group I.

Since the claims of Groups II, III, and IV appear to require the Examiner to search for the reshapable hair styling compositions recited in the claims of Group I, Applicants believe there can be no serious burden on the Examiner to search and examine all four Groups of claims simultaneously. There is every reason to believe the search and examination of Group I should fully encompass the search and examination for Groups II, III, and IV.

For the very same reasons, Applicants have shown that the Examiner's restriction based on distinction is based on a flawed understanding of what is recited in the claims of Groups I, II, III, and IV. Accordingly, "the burden shifts to the examiner to document a viable alternative . . . or withdraw the requirement."

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M.P.E.P. § 806.05(f), (g), & (h). It is not enough to identify the Groups as being from different classes. Id.

Furthermore, the Examiner has required an election of species under 35 U.S.C. § 121, irrespective of which Group is elected. The Examiner has required Applicants to elect a single species for each of the following components:

1. (meth)acrylic copolymer, preferably by also identifying units derived from (a) monomers, (b) monomers, and (c) monomers;
2. surfactant;
3. conditioning agent; and
4. cross-linking agent.

The election of species requirement is respectfully traversed. However, to be fully responsive to the election requirement, Applicants elect, with traverse, to prosecute the species described in Formulation A, which comprises sodium lauryl ether sulfate, cocobetaine, and Varisoft PATC as the surfactants, Merquat 550 as the conditioning agent, 2-ethyl hexyl acrylate/ n-butyl acrylate/ 2-hydroxy ethyl methacrylate as the (meth)acrylic copolymer. While the species of Formulation A does not utilize a crosslinking agent, Applicants elect divinylbenzene as the crosslinking agent for completeness. The elected species is believed to read on at least claims 1-9, 12-14, 16-23, 28-41, 44-46, 48-55, 60-70, 72-79, 84-95, 98-100, 102-108, 120-131, 134-136, 138-145, and 159-184 of Group I.

Applicants traverse the election of species requirement on the grounds that the Examiner has not shown that there would be a serious burden to examine all of

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the recited species. In fact, the Examiner has failed to show that any of the species are separately classified or how they would require burdensome bibliographic, manual, and/or computer searches. Accordingly, Applicants respectfully request that the full scope of the claimed invention be examined in this application without election requirement. Applicants respectfully contend that there is not an unreasonable number of species, and therefore this election requirement should be withdrawn. See 37 C.F.R. § 1.141 and MPEP § 806.04(a).

Applicants further note that the Examiner's election of species requirement may evidence a misunderstanding of the claimed invention. For clarity, Applicants note that the claimed invention is directed to compositions comprising (meth)acrylic copolymers. Accordingly, the species to be elected are species of the composition, as opposed to species of composition's components. Applicants have elected the species disclosed in Formulation A and elected a crosslinking agent for completeness since Formulation A did not utilize such an agent.

Accordingly, Applicants respectfully request that all the claimed species continue to be examined in this application. If the Examiner chooses to maintain the election of species requirement, Applicants expect the Examiner, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

In view of the foregoing remarks, Applicants respectfully submit that the

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restriction and election of species requirements are in error and request that the requirements be withdrawn. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: February 20, 2003

By: 
Anthony A. Hartmann
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